

REMARKS

The application was filed on 30 March 2001 with twelve claims. The Examiner examined the application and on 24 March 2005 issued a first Action. In the Examiner's Action, the Examiner rejected claims 5, 6, 8, 9, and 12 under 35 U.S.C. §112, second paragraph. The Examiner also rejected claims 1 and 4 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,765,138 entitled APPARATUS AND METHOD FOR PROVIDING INTERACTIVE EVALUATION OF POTENTIAL VENDORS to Aycock et al. (Aycock '138), claims 2, 3, 7-11 under 35 U.S.C. §103(a) as being unpatentable over Aycock '138; and claims 5, 6 and 12 under 35 U.S.C. §103(a) over Aycock '138 in view of U.S. Patent No. 5,627,973 entitled METHOD AND APPARATUS FOR FACILITATING EVALUATION OF BUSINESS OPPORTUNITIES FOR SUPPLYING GOODS AND/OR SERVICES TO POTENTIAL CUSTOMERS to Armstrong (Armstrong '973). Applicants amended the claims, cancelled claims 10-12 and added claims 13-20.

The Examiner responded on 07 October 2005 by maintaining the rejection of claims 6 and 9 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner further issued new rejections of claims 1-9 and 13-20 under 35 U.S.C. §112, 1<sup>st</sup> paragraph; and 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §101 alleging that the invention is directed to non-statutory subject matter, asserting that the claimed invention does not produce a useful, concrete, and tangible result. Applicants amended claims 1, 6, 7, and 9, and removed an abbreviation from the other claims.

The Examiner then issued another Action mailed 03 April 2006 and rejected claims 1-9, 13-20 under 35 U.S.C. §112, 1<sup>st</sup> paragraph; and 35 U.S.C. §112, 2<sup>nd</sup> paragraph. The Examiner maintained the rejection of the claims under 35 U.S.C. §101 alleging that the invention is directed to non-statutory subject matter stating that the claimed invention does not produce a useful, concrete, and tangible result. are pending. The Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §103(a) as being unpatentable over Daskalontonakis, Michael K., "ACHIEVING HIGHER SEI LEVELS" IEEE COMPUTER, Vol. 27, No. 7, pp. 17-24, July 1994 (hereinafter referred to as Daskalontonakis) and Paulk, Mark et al., "Capability Maturity Model for Software, Version 1.1, Technical Report CMU/SEI-93-TR-024" SOFTWARE ENGINEERING INSTITUTE, Carnegie Mellon University, Pittsburgh, Pennsylvania, February

1993 (hereinafter referred to as SEI; in previous responses referred to as CMM). In response, Applicants amended the claims and cancelled claim 20.

The Examiner then issued a final rejection of the claims in a detailed action mailed 25 September 2006. The Examiner objected to claim 15, and further rejected claims 1-6 under 35 U.S.C. §112, second paragraph. The Examiner maintained the rejection of claims 1-4, 6-9, 13-19 under 35 U.S.C. §102(b) as being anticipated by SEI. The Examiner also rejected claim 5 as being obvious over SEI.

In response, Applicants believe that patentable subject matter exists in this application and file a Request for Continued Examination with this amendment. Applicants have amended the claims, canceled claims 13 and 19, added claims 21 and 22, and rewrote claim 5 as new claim 23. Claims 1-9 and 14-18, and 21-23 are pending.

*The Objection to claim 15¶*

The Examiner objected to claim 15 because it is a duplicate of claim 14. Applicants respectfully request the Examiner to reconsider and remove the objection. Claim 14 is directed to **inventory** control, i.e., control the amount of goods maintained on a business's premises whereas Claim 15 is directed to **invention** control, i.e., the intellectual property of a business. Support in the originally filed specification for the distinction is given on page 12, line 13 which refers to **invention** control; and on the same page 12, line 15 which refers to **inventory** control. Respectfully, Applicants request the Examiner to withdraw the objection to claim 15.

*The Rejection of claims 1-6 and 13-19 under 35 U.S.C. §112, 2<sup>nd</sup> ¶*

The Examiner issues a rejection of claims 1-6 under 35 U.S.C. §112, first paragraph. Specifically the Examiner states that the claims as a whole recite a system but that the system has no physical components recited on which the data in the structure is to be stored, processed or manipulated. In response, Applicants amend claims 1-6 to be dependent upon a "method for evaluating the satisfaction and value of information technology services as perceived by external customers using information technology services provided by an information technology organization." Claims 13 and 19 are canceled, and claims 14-18 are made dependent upon independent method claim 7.

Respectfully, in view of the amendments, Applicants request the Examiner to withdraw the rejection of claims 1-6 and 14-18 under 35 U.S.C. §112, first paragraph.

*The Rejection of claims 1-4, 6-9 and 13-19 under 35 U.S.C. §102(b) and the Rejection of claim 5 under 35 U.S.C. §103(a)*

The Examiner rejected claims 1-4, 6-9 and 13-19 under 35 U.S.C. §102(b) as being unpatentable over SEI, and rejected claim 5 under 35 U.S.C. §103(a) over SEI.

In view of the amendments, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §§102(b) and 103(a) because both references deal only with the realm and process of software development and software engineering within an information technology organization, there is no mention or hint of applicability of evaluating an external customer's perception of information technology services. As an additional basis for the traversal of the rejection, both references teach that their systems and methodologies are used internally in a software engineering environment. Daskalantonakis teaches a methodology "as an internal tool to help organizations prepare for a formal SEI [Software Engineering Institute] assessment." (Emphasis added) The SEI assessment is set forth in the SEI reference. At page 27 of the SEI reference, four uses are supported by the SEI, all of which are internally directed: assessment teams to identify strengths and weaknesses in the organization; evaluation teams to identify risk of selecting different contractors for awarding business and monitor contracts; managers and technical staff to plant and implement a software process improvement program for their organization; and process improvement groups to define and improve the software process in their organization. Thus, neither reference suggests monitoring customer satisfaction with an end product in the information technology industry.

In fact, Applicants specifically teach against the approach used by Daskalantonakis and CMM: in the specification at page 4, Applicants state:

One approach to evaluating the effectiveness of an IT operation is to focus on the processes and procedures which are employed by the IT operation itself. This is sometimes referred to as a production method, since it focuses on the production of IT deliverables in assessing the effectiveness and the adequacy of the IT operations. [describing SEI and Daskalantonakis exactly] This is also an inwardly aligned evaluation [that] does assess in evaluating the efficiency of the IT infrastructure by aligning the goals and initiatives across the enterprise's

processes. It allows an emphasis on repeatability, consistency and robust process execution across an enterprise.

However, process assessment (looking at the processes used in the IT organization may be a useful indicator of IT effectiveness but it is not as good an indicator of the satisfaction and value as perceived by the users of the IT services (the external customers who are using the IT services being provided by the IT organization). Page 4, lines 1-11.

....

The present invention has the advantage that it focuses on the perception of the customers in evaluating the effectiveness of the IT delivery system and is therefor sometimes characterized as an evaluation of the delivery or outward manifestation of the IT system rather than an inward evaluation of the production system. Page 5, lines 16-19. (Emphasis added)

### Conclusion

Having thus amended the claims to recite a method, rather than a system, Applicants overcome the rejection of the claims under 35 U.S.C. §112, first paragraph. Applicants have narrowed the claims providing specific examples of service attributes, questions, focus areas, considerations, and examples for and of the delivery of information technology services to an external customer. By doing so, Applicants have overcome the rejections under 35 U.S.C. §§ 102(b) and 103(a) because the references teach an inwardly-focused process improvement for software development project. Applicants, on the other hand, claim an outwardly-focused evaluation of customer satisfaction of information technology services. Applicants request the Examiner to allow all claims. The Examiner is further invited to telephone the Attorney listed below if she thinks it would expedite the prosecution and the issuance of the patent.

Respectfully submitted,

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